

REMARKS

2-4. The application is objected to because a statement listing required information is required, identification of the disk and the files contained on each disk including the filename, file size, and file creation date is required and insertion in the specification of an incorporation-by-reference of the material on the compact disk is required.

The required information is being sought, and the specification will be amended to incorporate it as required in due course.

5-6. Claims 1-3 and 9-13 stand rejected under 35 U.S.C. §102(b) as being anticipated by Christie.

7. As to claim 1, the reference is said to disclose the invention as claimed including a method of work sharing and communicating over the internet with a website system (abstract; and col. 8, lines 5-13) that is said to include at least a communication component and a data storage component (FIG. 2B; and col. 9, lines 10-50) allowing users to electronically input data over the internet (FIG. 2B) comprising electronically storing the data received over the internet in the data storage component of the website system (col. 3, lines 24-25; 210, 220, FIG. 2B); automatically determining to which other related portions of the website system the electronically stored data will be sent (col. 4, lines 22-24); automatically distributing the electronically stored data to the automatically determined other related portions of the website system (col. 4, lines 24-27); electronically storing the data distributed to the other related portions of the website system in the data storage component (col. 4, lines 41-45); and automatically communicating over the internet to other relevant users of the newly stored data in the website system (col. 4, lines 24-27).

8. As to claim 11, the claim is said to be rejected for the same reasons as claim 1 above. In addition, the reference is said to disclose an apparatus for work sharing and communicating comprising a computer at a website system that includes at least a communication component and a data storage component allowing users in professional offices to electronically input data over the internet (FIG. 2B).

9. As to claim 2, the reference is said to disclose said automatically determining is controlled by a computer program programmed to determined which portions of the website system the electronically stored data will be sent (col. 9, line 66 to col. 10, line 20).

10. As to claim 3, the reference is said to disclose the computer program controls determining to which portions of the website system the electronically stored data is relevant, and is said to enact the automatic distribution to distribute the electronically stored data accordingly (col. 9, line 66 to col. 10, line 20).

11. As to claim 9, the reference is said to disclose the electronic storage occurs on a remote data processing machine that can be accessed from remote terminals via a channel from the group consisting of the internet and an intranet (FIG. 2B; and col. 8, lines 46-51).

12. As to claim 10, the reference is said to disclose the automatic distributing is controlled by a computer program programmed to distribute the electronically stored data to the automatically determined portions of the website system (col. 9, line 66 to col. 10, line 20).

13. As to claim 12, the reference is said to disclose the website system includes terminals intercoupled to the computer by a link (FIG. 2B; and col. 9, lines 16-25).

14. As to claim 13, the reference is said to disclose the data storage comprises data storage device that stores the first input data and a data storage device that stores the data distributed to the other related portions of the website system (col. 3, lines 24-31).

These grounds of rejection are respectfully traversed.

"It is well settled that anticipation under 35 U.S.C. 102 requires the presence in a single reference of all of the elements of a claimed invention." *Ex parte Chopra*, 229 U.S.P.Q. 230, 231 (BPA&I 1985) and cases cited.

"Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983).

"This court has repeatedly stated that the defense of lack of novelty (i.e., 'anticipation') can only be established by a single prior art reference which discloses each and every element of

the claimed invention.” *Structural Rubber Prod. Co. v. Park Rubber Co.*, 223 U.S.P.Q. 1264, 1270 (Fed. Cir. 1984), citing five prior Federal Circuit decisions since 1983 including *Connell*.

In a later analogous case the Court of Appeals for the Federal Circuit again applied this rule in reversing a denial of a motion for judgment n.o.v. after a jury finding that claims were anticipated. *Jamesbury Corp. v. Litton Industrial Prod., Inc.*, 225 U.S.P.Q. 253 (Fed. Cir. 1985).

After quoting from *Connell*, “Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim,” 225 U.S.P.Q. at 256, the court observed that the patentee accomplished a constant tight contact in a ball valve by a lip on the seal or ring which interferes with the placement of the ball. The lip protruded into the area where the ball will be placed and was thus deflected after the ball was assembled into the valve. Because of this constant pressure, the patented valve was described as providing a particularly good seal when regulating a low pressure stream. The court quoted with approval from a 1967 Court of Claims decision adopting the opinion of then Commissioner and later Judge Donald E. Lane:

[T]he term “engaging the ball” recited in claims 7 and 8 means that the lip contacts the ball with sufficient force to provide a fluid tight seal. \*\*\* The Saunders flange or lip only sealingly engages the ball 1 on the upstream side when the fluid pressure forces the lip against the ball and never sealingly engages the ball on the downstream side because there is no fluid pressure there to force the lip against the ball. The Saunders sealing ring provides a compression type of seal which depends upon the ball pressing into the material of the ring. \*\*\* The seal of Saunders depends primarily on the contact between the ball and the body of the sealing ring, and the flange or lip sealingly contacts the ball on the upstream side when the fluid pressure increases. 225 U.S.P.Q. at 258.

Relying on *Jamesbury*, the ITC said, “Anticipation requires looking at a reference, and comparing the disclosure of the reference with the claims of the patent in suit. A claimed device is anticipated if a single prior art reference discloses all the elements of the claimed invention as arranged in the claim.” *In re Certain Floppy Disk Drives and Components Thereof*, 227 U.S.P.Q. 982, 985 (U.S. ITC 1985).

All these rejected claims call for a method of work sharing and communicating over the internet with a website system, electronically storing the data received over the internet in the

data storage component of the website system, automatically determining to which other related portions of the website system the electronically stored data will be sent, automatically distributing the electronically stored data to the automatically determined other related portions of the website system, electronically storing the data distributed to the other related portions of the website system in the data storage component and automatically communicating over the internet to other relevant users of the newly stored data in the website system. Parent claim 1 recites website 6 times. A website is a set of interconnected pages, usually including a home page, generally located on the same server, and prepared and maintained as a collection of information by a person, group, or organization. At least because the reference does not disclose a website, it cannot anticipate any of the rejected claims. Accordingly, withdrawal of the rejection of claims 1-3 and 9-13 as anticipated by the reference is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to identify the column and line where the reference discloses a website as distinguished from the disclosed computer sites.

15-16. Claims 4-8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Christie as a primary reference in view of Swartz as a secondary reference.

17. As to claim 4, the primary reference is said to not necessarily disclose a portion of a knowledge-management system. The secondary reference is said to disclose a portion of a knowledge-management system in an information sharing and communicating system (col. 4, lines 12-15). It is said it would have been obvious to one skilled in the art at the time of the invention to combine the teachings of the primary and secondary references because the secondary reference knowledge-management system it is said would enhance the functionality of the primary reference system by permitting an efficient establishment and use of a knowledge repository in an organization or enterprise that reflects the collective learning of the individuals, shared groups, and systems employed by the organization (col. 5, lines 30-35, and col. 6, lines 8-10).

18. As to claims 5-8, the secondary reference is said to disclose the need for the knowledge-management system for a wide range of industries (col. 1, lines 33-54). It is said it would have been obvious to one skilled in the art at the time of the invention that a service

industry would also need knowledge-management system for the same obvious reasons of enhancing the prospects of the industry by permitting an efficient establishment and use of a knowledge repository within the industry that reflects the collective learning of the individuals, shared groups and system employed by the industry (col. 5, lines 30-35, and col. 6, lines 8-10). It is said it would have been obvious to one skilled in the art at the time of the invention that a service industry would be covering groups of a medical practice, hospital and a medical health maintenance organization, a group consisting of a law office, law firm, courthouse, and a legal business entity or a group consisting of an accounting firm, tax firm, temporary employment firm, financial and employment business entity.

These grounds of rejection of claims 5-8 are respectfully traversed.

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

"Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.'" *In re Laskowski*, 10 U.S.P.Q. 2d 1397, 1398 (Fed. Cir. 1989).

"The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so." *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original, footnotes omitted).

"The critical inquiry is whether there is something in the prior art as a whole *to suggest* the desirability, and thus the obviousness, of making the combination. [citing *Lindemann* with emphasis added.]" *Fromson v. Advance Offset Plate, Inc.*, 225 U.S.P.Q. 26, 31 (Fed. Cir. 1985).

Claims 5-8 are dependent upon and include all the limitations of claims 1-4, including the website limitation absent from both the primary and secondary references. Nothing in the references suggest the desirability of combining what is there disclosed to meet the limitations of claims 5-8. Furthermore, it is impossible to combine the references to meet the terms of claims 5-8.

"Moreover, we observe that even if these references were combined in the manner proposed by the examiner, that which is set forth in appellant's claims . . . would not result." *Ex parte Bogar*, slip op. p.7 (BPA&I Appeal No. 87-2462, October 27, 1989). "Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed." *Ex parte Schwarz*, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992). "Although we find nothing before us indicating why it would be desired to combine the references in the manner urged by the examiner, it is clear to us that such a modification by itself would not result in that which is set forth in the claims." *Ex Parte Kusko*, 215 U.S.P.Q. 972, 974 (BPA&I 1981).

That it is impossible to combine the references to meet the terms of claims 5-8 is reason enough for withdrawing the rejection of them.

Accordingly, withdrawal of the rejection of claims 5-8 as unpatentable over the primary and secondary references is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in the references regarded as corresponding to each element in these rejected claims and quote verbatim the language in the references regarded as suggesting the desirability of combining what is there disclosed to meet the terms of these claims.

19-21. Claim 14 stands rejected under 35 U.S.C. §102(b) as being anticipated by Hunnicut. The reference is said to disclose a method for enrolling and grouping users in

professional offices comprising assigning enrolled users into specific work groups (said to be inherent in col. 7, lines 38-40), assigning the specific work groups levels of access to a website system over the internet (said to be inherent in col. 7, lines 40-62), limiting the specific work group to the assigned level of access to the website system (col. 7, lines 59-62, and FIG. 5), and providing communication capabilities over the internet to the specific work groups which are limited to the work group's assigned level of access (said to be inherent in col. 7, lines 50-55).

This ground of rejection is respectfully traversed.

Like the Christie and Swartz patents, the Hunnincut patent fails to disclose a website. Accordingly, the reference cannot anticipate claim 14 which calls for, inter alia, assigning the specific work groups levels of access to a website system over the internet and limiting the specific work group to the assigned level of access to the website system. Accordingly, withdrawal of the rejection of claim 14 as anticipated by Hunnincut is respectfully requested. Should this ground of rejection be maintained, the Examiner is respectfully requested to identify the column and line in the reference where a website is disclosed.

22. The courtesy of the Examiner in conducting a diligent search is acknowledged with appreciation. The references cited, but not applied, have been examined and are submitted to be incapable of anticipating, suggesting or making obvious the subject matter as a whole of the invention disclosed and claimed in this application.

In view of the foregoing authorities, remarks and the inability of the prior art, alone or in combination, to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the claims are submitted to be in a condition for allowance upon correcting the informalities noted in paragraphs 2-4, and notice thereof is respectfully requested. Should the Examiner believe the application is not in a condition for allowance, he is respectfully requested to telephone the undersigned attorney at (617) 521-7014 to discuss what additional steps the Examiner believes are necessary to place the application in a condition for allowance.

Applicant : Andrea Waxler  
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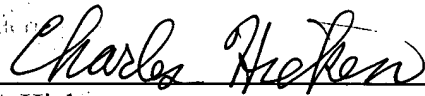
Attorney's Docket No.: 11790-003001 / AAFIRP01

Enclosed is a \$475.00 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050, Order No. 11790-003001.

Respectfully submitted,

FISH & RICHARDSON P.C.

Date: APR - 9 2004



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Enclosure: Definition of "website"

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**web-site** or **Web site** (wěb'sīt') 

*n.*

A set of interconnected webpages, usually including a homepage, generally located on the same server, and prepared and maintained as a collection of information by a person, group, or organization.

**USAGE NOTE** The transition from *World Wide Web site* to *Web site* to *website* seems to have progressed as rapidly as the technology itself. The development of *website* as a single uncapitalized word mirrors the development of other technological expressions which have tended to evolve into unhyphenated forms as they become more familiar. Thus *email* has recently been gaining ground over the forms *E-mail* and *e-mail*, especially in texts that are more technologically oriented. Similarly, there has been an increasing preference for closed forms like *homepage*, *online*, and *printout*.



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